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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,430	12/14/2001	Shigeki Kuroda	35.C16053 US	3749
5514	7590	10/21/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PATTERSON, RASHAN OMAR	
			ART UNIT 2622	PAPER NUMBER
DATE MAILED: 10/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,430

Applicant(s)

KURODA, SHIGEKI

Examiner

Rashan O. Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-17-04 3-23-04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Reissued Action**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9 and 19 are drawn to a program that merely manipulates data or an abstract idea, or merely solves a mathematical problem without limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application it must produce a "useful, concrete and tangible result" *State Street*, 143 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of a "physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan", or "limited to a practical application within the technological arts" (MPEP 2106 IVB2(b)). Currently, claim 16 meets neither of these criteria. In order for the claimed process to produce "useful, concrete and tangible" result, recitation of one of the following elements is suggested:

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- i. The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- ii. A recitation of a physical transformations outside the computer, for example in the form of pre or post computer processing activity) MPEP 2106 IVB2(b)(i)).
- iii. A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2 (b)(ii)).

Note: In order for computer programs to be considered statutory, they must be contained on a computer readable medium.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over) Stone et al. (EP 0729118 A2) in view of Kremers et al. (US 5007625).

Regarding claims 1, 5, 9 and 10 Stone et al. discloses an information processing apparatus (Fig 2) comprising counting means for counting the

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number of physical sheets to which the document data of one copy whose output is desired is allocated (Col 4 lines 36-38).

Stone et al. does not disclose the information processing apparatus comprising finishing command setting means which can set a finishing command to a printer as to rotation-sort-output or Offset –output document data; and wherein said finishing command setting means sets said finishing command in a manner such that in the case where there document data of one copy is printed onto one physical sheet as a result of the counting by said counting means, the rotation sort output or the Offset output is not performed, and in the case where the document data of one copy is printed onto two or more physical sheets, the rotation sort output or the Offset output is performed.

Kremers et al. discloses the information processing apparatus comprising finishing command setting means which can set a finishing command to a printer as to rotation-sort-output or Offset –output document data (Col 8 lines 1-5, lines 21-23); and wherein said finishing command setting means sets said finishing command in a manner such that in the case where there document data of one copy is printed onto one physical sheet, the rotation sort output or the Offset output is not performed, and in the case where the document data of one copy is printed onto two or more physical sheets, the rotation sort output or the Offset output is performed (Col 8 lines 1-5, lines 21-23).

Stone et al. and Kremers et al. are combinable because they both incorporate using an information processing apparatus.

It would have been obvious at the time of the invention for one

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skilled in the art to combine Stone et al. with Kremers et al.

The motivation for doing so would have been to have the information processing apparatus comprising finishing command setting means which can set a finishing command to a printer as to rotation-sort-output or Offset-output document data; and wherein said finishing command setting means sets said finishing command in a manner such that in the case where there document data of one copy is printed onto one physical sheet as a result of the counting by said counting means, the rotation sort output or the Offset output is not performed, and in the case where the document data of one copy is printed onto two or more physical sheets, the rotation sort output or the Offset output is performed as shown in Col 8 lines 1-5, lines 21-23.

Therefore it would have been obvious to combine Stone et al. with Kremers et al. to obtain the invention as specified in claims 1, 5, 9, and 10.

Regarding claims 2, 6, 12, and 16, Stone et al. discloses an apparatus as modified by Kremers et al. further comprising print mode setting means for setting a print mode of the document data ( Col 5 lines 31-40) and wherein said print mode setting means has layout print setting means for arranging a plurality of logical pages to one page of the physical sheet (Col 4 lines 38-44).

Stone et al. and Kremers et al. are combinable because they both incorporate using an information processing apparatus.

It would have been obvious at the time of the invention for one skilled in the art to combine Stone et al. with Kremers et al.

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The motivation for doing so would have been to have an apparatus as modified by Kremers et al. further comprising print mode setting means for setting a print mode of the document data as in Col 5 lines 31-40 and wherein said print mode setting means has layout print setting means for arranging a plurality of logical pages to one page of the physical sheet Col 4 lines 38-44.

Therefore, it would have been obvious to combine Stone et al. with Kremers et al. to obtain the invention as specified in claims 2,6,12 and 16.

Regarding claims 3,7, 13, and 17 Stone et al. discloses an apparatus as modified by Kremers et al. further comprising print instructing means for instructing executing of printing (Col 4 lines 38-44); and a spooling means for spooling said document data as intermediate data of a data format different from that of said document data ( Col 4 lines15-18); where in counting means executes the counting on the basis of said intermediate data spooled by said spooling means (Col 4 lines 36-38).

Stone et al. and Kremers et al. are combinable because they both incorporate using an information processing apparatus.

It would have been obvious at the time of the invention for one skilled in the art to combine Stone et al. with Kremers et al.

The motivation for doing so would have been to have an apparatus as modified by Kremers et al. further comprising print instructing means for instructing executing of printing as in Col 4 lines 38-44; and a spooling means for spooling said document data as intermediate data of a data format different from that of said document data as in Col 4 lines15-18; where in counting means

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executes the counting on the basis of said intermediate data spooled by said spooling means as in Col 4 lines 36-38.

Therefore, it would have been obvious to combine Stone et al. with Kremers et al. to obtain the invention as specified in claims 3,7,13 and 18.

Regarding claims 4, 8, 14, and 18 Stone et al. discloses an apparatus as modified by Kremers et al. further comprising intermediate data editing means for making a layout print control of said intermediate data on the basis of the number counted by said counting means and the print mode setting means (Col 4 lines 36-38; Col 5 lines 31-40); intermediate data output means for outputting said edited intermediate a data (Col 4 lines 19 – 25); print data generating means for generating print data from said outputted intermediated data (Col 4 lines 19-25).

Stone et al. and Kremers et al. are combinable because they both incorporate using an information processing apparatus.

It would have been obvious at the time of the invention for one skilled in the art to combine Stone et al. with Kremers et al.

The motivation for doing so would have been to have an apparatus as modified by Kremers et al. further comprising intermediate data editing means for making a layout print control of said intermediate data on the basis of the number counted by said counting means and the print mode setting means as in Col 4 lines 36-38; Col 5 lines 31-40; intermediate data output means for outputting said edited intermediate a data as in Col 4 lines 19 – 25; print data generating means for generating print data from said outputted intermediated data as in Col 4 lines 19-25).



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Therefore, it would have been obvious to combine Stone et al. with Kremers et al. to obtain the invention as specified in claims 4,8,14 and 18.

Regarding claims 11, 15, 19 and 20 Stone et al. discloses the information processing apparatus comprising counting means for counting the number of physical sheets to which the document data of one copy whose output is desired is allocated

Stone et al. does not disclose the information processing apparatus comprising having finishing command setting means which can set a finishing command to a printer so as to rotation-sort-output or Offset-output document data, comprising; finishing command editing means for canceling the finishing command set so as to allow said finishing command setting means to execute the finishing operation in the case where the document data of one copy is printed onto one physical sheet as a result of the counting by said counting means.

Kremers et al. discloses the information processing apparatus comprising having finishing command setting means which can set a finishing command to a printer so as to rotation-sort-output or Offset-output document data, comprising; finishing command editing means for canceling the finishing command set so as to allow said finishing command setting means to execute the finishing operation in the case where the document data of one copy is printed onto one physical sheet (Col 8 lines 1-4, lines 21-24).

Stone et al. and Kremers et al. are combinable because they both incorporate using an information processing apparatus.

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It would have been obvious at the time of the invention for one skilled in the art to combine Stone et al. with Kremers et al.

The motivation for doing so would have been to have the information processing apparatus comprising having finishing command setting means which can set a finishing command to a printer so as to rotation-sort-output or Offset-output document data, comprising; finishing command editing means for canceling the finishing command set so as to allow said finishing command setting means to execute the finishing operation in the case where the document data of one copy is printed onto one physical sheet as a result of the counting by said counting means as disclosed in Col 8 lines 1-4, lines 21-24.

Therefore, it would have been obvious to combine Stone et al. with Kremers et al. to obtain the invention as specified in claims 11,15,19 and 20.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Holt (US 5495561) discloses and Operating System with object oriented printing interface. Shaw ( US 5845058) discloses a device independent spooling in a print architecture. Gusfafson et al. (US 4188025) reveals an Offset sheet stacking apparatus. Mandel (US 5501442) shows a dual mode tamper/offsetter. Adachi et al.(US 5774778) reveals a sheet post-processing apparatus and image forming apparatus having same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashan O. Patterson whose telephone

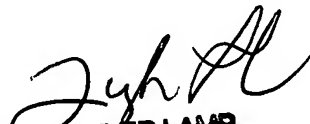
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number is 571-272-0597. The examiner can normally be reached on Mon - Fri 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROP



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